

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Application Serial No. 78/128,404
Published in the Official Gazette on February 4, 2003
Mark: RUBEXIS and Design (Horse Head)



08-04-2003

U.S. Patent & TMO/TM Mail Rpt Dt. #22

PDB SPORTS, LTD. d/b/a DENVER
BRONCOS and NFL PROPERTIES LLC,

Opposers,

-against-

RUBEXIS INTERNATIONAL LINK LLC,

Applicant.

Opposition No. _____

NOTICE OF OPPOSITION

TO THE ASSISTANT COMMISSIONER FOR TRADEMARKS:

Opposers PDB Sports, Ltd. d/b/a Denver Broncos and NFL Properties LLC believe they will be damaged by registration of the RUBEXIS and Design (Horse Head) mark as shown in the above-identified application and hereby oppose the same pursuant to Section 13(a) of the Trademark Act of 1946, as amended (the "Lanham Act"), 15 U.S.C. § 1063(a).

As grounds for the opposition, Opposers allege that:

1. Opposer PDB Sports, Ltd. d/b/a Denver Broncos (the "Broncos"), a limited partnership organized and existing under the laws of Arizona with its principal place of business at 13655 Broncos Parkway, Englewood, Colorado 80112, owns and operates a professional football team that provides entertainment services to the public in the form of competitive football games. The Broncos football franchise is one of the thirty-two member clubs (the "Member Clubs") of the National Football League (the "NFL").

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2. Opposer NFL Properties LLC ("NFLP") is a limited liability company organized and existing under the laws of Delaware with its principal place of business at 280 Park Avenue, New York, New York 10017. NFLP has been licensed exclusively by the NFL and each of the Member Clubs, including the Broncos, to use their respective trademarks for commercial purposes, to promote the NFL and its Member Clubs and to protect their trademarks. NFLP has licensed hundreds of companies to use the marks of the NFL and its Member Clubs, including those of the Broncos, in promotion of their goods and services.

3. For many years and long before May 13, 2002, the filing date of the intent-to-use application for the RUBEXIS and Design (Horse Head) mark herein opposed, Opposers and their authorized business partners, sponsors and licensees have used a Horse Head Design mark and variations thereof ("BRNCOS Horse Head Design Marks") in connection with their business of organizing, conducting and promoting the Broncos and the NFL.

4. The BRNCOS Horse Head Design Marks are inherently distinctive because they are arbitrary with respect to the goods and services of Opposers and their authorized business partners, sponsors and licensees.

5. Opposers and their authorized business partners, sponsors and licensees have sold and offered for sale goods and services bearing the BRNCOS Horse Head Design Marks in a trading area of broad geographic scope encompassing, inter alia, all of the states and territories of the United States.

6. During their long, widespread and continuous use of the BRNCOS Horse Head Design Marks, Opposers and their authorized business partners, sponsors and licensees have expended considerable time, effort and money in the advertisement and promotion of goods and services in connection with the BRNCOS Horse Head Design Marks, and the BRNCOS

Horse Head Design Marks embody great and valuable goodwill belonging exclusively to Opposers.

7. The on-field success of the Broncos franchise, along with the marketing efforts of the NFL, has led to nationwide coverage of the activities of the Broncos and to many thousands of references in the print, broadcast and Internet media to the BRONCOS Horse Head Design Marks. The widespread use by the media of the BRONCOS Horse Head Design Marks when referring to the Broncos has contributed to the strong public association of the BRONCOS Horse Head Design Marks with the Broncos. Such use and association inure exclusively to the benefit of Opposers.

8. The BRONCOS Horse Head Design Marks have a high degree of acquired distinctiveness due to the duration and extent of use, advertising and publicity of the BRONCOS Horse Head Design Marks by Opposers, their authorized business partners, sponsors and licensees, and the media.

9. Opposers' widespread use of the BRONCOS Horse Head Design Marks on a variety of goods and services, Opposers' extensive marketing of such goods and services and the thousands of uses by the media of the BRONCOS Horse Head Design Marks when referring to the Broncos have contributed to the strong public association of the BRONCOS Horse Head Design Marks with Opposers, and have made the BRONCOS Horse Head Design Marks famous. Therefore, the BRONCOS Horse Head Design Marks are widely recognized nationally and internationally, and are synonymous with the Broncos in the minds of consumers.

10. In addition to Opposers' common law rights in the BRONCOS Horse Head Design Marks, the Broncos own, inter alia, the following federal trademark registrations:

<u>Registration Number</u>	<u>Mark</u>	<u>International Class</u>	<u>Date of First Use</u>
2,175,702	Horse Head Design Mark	16	02/04/97
2,177,559	Horse Head Design Mark	28	03/97
2,177,558	Horse Head Design Mark	41	02/04/97
2,177,555	Horse Head Design Mark	25	02/97

All of the above-listed registrations have become incontestable pursuant to Section 15 of the Lanham Act, 15 U.S.C. § 1065.

11. By the application herein opposed, Applicant seeks to register the RUBEXIS and Design (Horse Head) mark in International Class 35 for use in connection with "[i]mport and export services in the field of chemicals and sealants for use in historical preservation, arts and collectibles, furnitures, and software for business and industrial management."

12. Opposers will be damaged by the registration sought by Applicant because such registration will support and assist Applicant in the confusing and misleading use of the RUBEXIS and Design (Horse Head) mark, and will give color of exclusive statutory rights to Applicant in violation and derogation of the prior and superior rights of Opposers.

13. Registration should be refused pursuant to Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a), on the grounds that Applicant's use of the RUBEXIS and Design (Horse Head) mark falsely suggests a connection between Applicant and Opposers, to the damage of Opposers.

14. Registration should be refused pursuant to Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), on the grounds that RUBEXIS and Design (Horse Head) mark so resembles

the BRANCOS Horse Head Design Marks used consistently by Opposers in the United States for many years, as to be likely, when used on or in connection with Applicant's goods, to cause confusion, or to cause mistake, or to deceive, with consequent injury to Opposers and to the public.

15. Registration should be refused pursuant to Sections 2(f) and 13(a) of the Lanham Act, 15 U.S.C. §§ 1052(f) and 1063(a), on the grounds that Opposers will be damaged by the registration sought by Applicant because the registration will dilute the distinctive and famous quality of the BRANCOS Horse Head Design Marks.

WHEREFORE, Opposers believe they will be damaged by the registration by Applicant of the RUBEXIS and Design (Horse Head) mark, and respectfully request that the opposition be sustained and registration of said mark be denied.

This Notice of Opposition is filed in duplicate as required by 37 C.F.R. § 2.104(a). Pursuant to 37 C.F.R. §§ 2.6(a)(17) and 2.104(b), please charge the requisite amount of six hundred dollars (\$600) to Deposit Account Number 23-1705 to cover the statutory fee for filing a notice of opposition by two Opposers in one International Class. Please also charge any additional amounts to Deposit Account No. 23-1705.

All communications should be addressed to Opposers' counsel, White & Case
LLP, at the below stated address.

Dated: New York, New York
August 4, 2003

Respectfully submitted,

WHITE & CASE LLP

By: 

Robert L. Raskopf
Claudia T. Bogdanos
1155 Avenue of the Americas
New York, New York 10036

ATTORNEYS FOR OPPOSERS PDB
SPORTS, LTD. d/b/a DENVER BRONCOS
AND NFL PROPERTIES LLC

CERTIFICATE OF MAILING BY "EXPRESS MAIL"

"Express Mail" mailing label number: **EL608307080US**

I hereby certify that this document and instructions for payment of fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service in an envelope addressed to the Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513 on this 4th day of August 2003.

Signature: 

James H. Sullivan

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August 4, 2003

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U.S. Patent & TMOfo/TM Mail Rpt Dt. #22

Box TTAB - FEE
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

Re: Notice of Opposition by PDB Sports, Ltd. d/b/a Denver Broncos and NFL Properties LLC to Application of Rubexis International Link LLC, Serial No. 78/128,404; Mark: RUBEXIS and Design (Horse Head)

To the Assistant Commissioner:

I enclose the original and one copy of the Notice of Opposition by PDB Sports, Ltd. d/b/a Denver Broncos and NFL Properties LLC to the above-referenced application.

Please charge Deposit Account Number 23-1705 the requisite amount of six hundred dollars (\$600.00) to cover the statutory fee for filing a Notice of Opposition by two Opposers in one International Class. Please also charge any additional amounts to Deposit Account No. 23-1705.

Please stamp and return the enclosed postcard to acknowledge receipt of the Notice of Opposition and appropriate fee. Please also conduct all correspondence with regard to the above-referenced application with the undersigned.

Sincerely,

James H. Sullivan

Enclosures